

REMARKS

Claims 1-30 remain pending in this application. Further reconsideration of this application is requested.

The withdrawal from consideration of claims 15-30 is traversed. The Examiner alleges that the invention of claims 15-30 as amended is "independent or distinct" from the invention originally claimed, for the reason that "the system for playing a card game" has not been originally claimed. It is respectfully submitted that this position is incorrect, because the invention recited in claims 15-30 as amended is neither independent nor distinct from the invention as set forth in claims 15-31 as originally filed. Additionally, it is not a proper basis upon which to found a restriction requirement to conclude that the invention of an amended claim is independent or distinct from that originally claimed, simply by virtue of the fact that the claim has been amended.

Claim 15 as originally presented was directed to a system for playing a game comprising a machine readable game card, a reader for reading the game card, a computer connected to the reader, wherein the game is played by placing the machine readable game card on the reader and identifying it with the computer. Claim 15 as amended is directed to the system, which includes a plurality of game cards.

The Examiner's attention is directed to MPEP § 806.04 for guidance as to the proper determinations that need to be made before concluding that inventions are independent or distinct and thus properly subject to restriction. Examples are: two different combinations not disclosed as being usable together and having different modes of operation or different functions, such as a shoe and a locomotive bearing; process and apparatus, where the apparatus cannot be used to practice the process, or independent species under a genus. The Examiner has failed to establish that claims 15-30 fall under any of these categories with respect to claims 1-14 or 15-30 as originally filed, and thus the Examiner has failed to show that the invention of claims 15-30 is independent of the invention of original claims 15-30 or of claims 1-14.

Similarly, the Examiner has failed to make any showing or explanation that claims 15-30 are directed to an invention that is distinct from the invention of claims 1-14 or original claims 15-30. See MPEP § 806.05. Examples of distinct inventions include: combination and subcombination, old combination and novel subcombination;

subcombinations usable together; process and apparatus for practice of the process; process of making and product made; apparatus and product made; product and process of using; product and process of making. None of these categories is applicable to claims 15-30 as amended vis-a-vis either claims 1-14 or original claims 15-30. Consequently, the restriction requirement and withdrawal of claims 15-30 from consideration is respectfully submitted to be improper, and reinstatement of claims 15-30 is respectfully urged.

The rejection under 35 U.S.C. § 102 of claims 1-6 and 8-12 as being anticipated by Irwin, and the rejection under 35 U.S.C. § 103 of claims 7, 13 and 14 as being unpatentable over Irwin in view of Pieterse, are respectfully traversed.

The present invention as claimed is directed to a machine readable game card and system for playing a card game, wherein the game card has a display surface containing an image representative of a particular value, and a readable surface including a path having an attribute of a predetermined value corresponding to said particular value represented by said image. According to the invention, the value of the game card is capable of being determined by making a simple measurement of the path attribute value between two terminals of the path, without having to rely on a database or other data storage medium, as is the case with conventional readable cards using bar codes, magnetic stripes or other optical or mechanical readers. For example, as shown in Fig. 2, card 101 contains an image on its display surface 201, indicating 10 points. Accordingly, the path 302 formed on readable surface 301 of the card 101 has an attribute value of 10 as measured between terminals 303 and 304 (e.g., 10 millivolts, 10 ohms, 10 milliamps, etc.). The card game system identifies game cards by placing them in a card reader connected to a computer having access to the game.

In contrast, none of the prior art references relied upon to reject the claims discloses or suggests a machine readable game card or system for playing a card game as claimed. Irwin discloses an electronic validation machine for documents such as probability lottery game cards, wherein a portion of an electrical circuit is formed on the card, which circuit has a known electrical signature that will be changed if the card is altered from its initial state. Irwin does not disclose a card game played with a

computer. Irwin does not disclose that the attribute value of the electrical circuit corresponds to a predetermined value represented by an image on the card. In this regard, Irwin is no more relevant than the Behm patent discussed at page 2 of the specification and cited in the Information Disclosure Statement filed in the present application. Clearly, the validation system of Irwin cannot have a value that reveals the value of the prize images on the card, as such would defeat the randomness characteristic of the lottery card.

The Final rejection counters that Irwin teaches a game card having at least one path arranged on a readable surface with two terminals and a certain resistance between the terminals, which can be measured. However, to repeat, **Irwin does not disclose that the attribute value of the electrical circuit corresponds to a predetermined value represented by an image on the card.** Claim 1 requires an image arranged on the display surface of the card, where the image is representative of a particular value, and wherein the predetermined value of the path measured between two terminals has a one-to-one correspondence with the particular value represented by the image. The Final rejection has failed to show where Irwin discloses such features, and consequently the rejection of claims 1-6 and 8-12 is improper on its face as a matter of law.

The rejection of claims 7, 13 and 14 also is improper. Pieterse discloses a joystick device for remotely playing games, having a card slot 14 for accepting a smart card 2. The smart card 2 is used either to pay for the games or to collect prizes via a telephone network. The smart card 2 is not a game card. Pieterse does not disclose any card game playable with the joystick pointer device. The smart card 2 does not contain any image representing any value, and does not have any path with a measurable attribute between two terminals that corresponds to the value represented by any image. The value in the smart card 2 does not identify the card, and thus reading of the value in the smart card does not correspond to identifying a game card of a card game as disclosed and claimed.

The Final rejection does not rebut any of the above arguments regarding the shortcomings of Pieterse. Instead, the Final rejection argues that Pieterse is properly combinable with Irwin, mischaracterizing Applicants' argument as being that the

references are not properly combinable with each other. To the contrary, Applicants' argument was not that the references are not combinable, but rather Applicants' argument as clearly stated in the last response is that even if Pieterse were to be combined with Irwin, the claimed invention would not be attained, because Pieterse does not cure the fundamental deficiency of Irwin with respect to the claimed invention. This rejection is thus improper and should be withdrawn.

Inasmuch as neither Irwin nor Pieterse disclose the novel features as set forth in claims 1-30, no combination of those prior art references could result in the claimed invention under an obviousness theory. Accordingly, reconsideration and withdrawal of the outstanding grounds of rejection are requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and the issuance of a Notice of Allowance of all of claims 1-30 is earnestly requested.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2135.

RESPECTFULLY SUBMITTED,					
NAME AND REG. NUMBER	Vincent M. DeLuca Attorney for Applicants Registration No. 32,408				
SIGNATURE	<i>Vincent M DeLuca</i>		DATE	<i>16 JUL 04</i>	
Address	Rothwell, Figg, Ernst & Manbeck 1425 K Street, N.W., Suite 800				
City	Washington	State	D.C.	Zip Code	20005
Country	U.S.A.	Telephone	202-783-6040	Fax	202-783-6031